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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/253,014 02/19/99 WOOLSTON

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EXAMINER

TM02/0411

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ART UNIT

PAPER NUMBER

2165

DATE MAILED:

04/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/253,014

Applicant(s)

Woolston

Examiner

M. Kemper

Group Art Unit
2165



☒ Responsive to communication(s) filed on Feb 2, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 11-25, 33-55, 64-99, and 139-218 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11-25, 33-55, 64-99, and 139-218 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 26

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 148-152, 154-158, 160-164, 166-170, 172-176, 178-182, 184-188, 190-194, 196-200, 202-206, 213-217 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Cited portion of the specification does not clearly provide support for the seller inputting auction duration, start/end time, immediate start, or indication that the auction is to be invoked by the seller manually. Please provide specific portions of the specification which support these new claims or cancel above claims.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11, 13, 16, 18-23, 33, 35, 39-41, 43-45, 49-50, 54, 55, 64-70, 74-85, 90, 93-96, 133-146, 148-218 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon et al., patent number 5,592,375 in view of Sharp "From Army Knives to Gold Coins, Collectors Attend 'On-Line' Auction" Memphis Business Journal v.8, n.10 p.10 7/86 further in view of Wright et al., "Is it Time to Travel the Auction Route?" Real Estate Today, v. 24, no.6, p.46(5).

Salmon teaches a method for conducting sales on the Internet comprising: receiving at a communication handler program executing on a host computer information from a seller corresponding to an item for sale, the information received from the seller including a designation

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of a category (col. 1, lines 15-45, col. 2, line 20, 25-55, col. 6, lines 25-45, col. 7, lines 5-25, col. 14, lines 1-5, 20-35, col. 15, lines 14-20); processing the received information into a presentation format by a database-to-presentation format formatting program the presentation format including an indication of the category of the item (col. 7, lines 32-40 fig.1, col. 4, lines 5-40); and a tracking identifier or unique item identifier (product ID); receiving a page of information including category designation (fig. 7g). Salmon also teaches the information received from a seller further comprises an item subcategory (figs. 4p, 4q); information received from a seller comprises a verbal description or a graphical description or both (col. 2, lines 30-35).

Sharp teaches an on-line auction which accepts messages concerning collectibles for sale and asking price or reserve price and bids from participants for items where submitting payment information is inherent since this is at minimum a requirement to offer a legitimate bid, subjective information including authenticity, sellers and buyers register including identity information⁶⁹ (inherent for the security check performed) before auction, and inherently seller financial⁷⁰ information since this is necessary for at least registration fees and commission fees and monthly charges (whole document). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the online auctioning as described in Sharp as a replacement for the sales in Salmon since the sellers have a possibility of receiving more money than the asking price or base price for the items thereby providing incentive to users to choose auctioning over brokering. Alternatively it would have been obvious to have used the buyers and sellers interface of Salmon in the system of Sharp since the system of Salmon would have provided an automated

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system for inputting information into the database of Sharp and would have provided a more enhanced auctioning system by providing users with more information in terms of graphics/multimedia thereby promoting use by the public.

Wright teaches accepting input relating to scheduling an auction (sellers set the day of selling- page 1). Wright also teaches the seller includes a price for the item (minimum-bid or reserve) and advertising (More Details to Plan section). It would have been obvious to one having ordinary skill in the art at the time of the invention to have allowed the seller to set the scheduling of the auction and conducted the auction of the item based on the schedule in the systems of Salmon and Sharp since allowing the seller to set the schedule would have offered control to the seller and accommodate the seller's needs (for example, for quick cash or credit to account) thereby providing incentive over the sale of Salmon or lack of seller control of Sharp. It also would have been obvious to have the seller indicate if advertising is offered since advertising would have generated interest in the item and auction as suggested by Wright. It also would have been obvious to have advertised on a main web page or a welcome page since these pages are more likely to be seen by more people. It also would have been obvious to have included a specified time period or duration or start and end time or even an immediate auction since this would also have accommodated at least the needs of the seller thereby encouraging use over Salmon and Sharp. While the term "Internet" does not appear in the references, it would have been obvious to have used the Internet since this would have provided convenience and accessibility to many users over the world (as opposed to a closed or dedicated network) thereby

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increasing the customer base and since Salmon includes use of an Ethernet network which supports TCP/IP protocols necessary for the Internet.

It also would have been obvious to have the presentation format comprising a hypertext markup language format since this is well known in the art for linking information as is desired by Salmon (col. 2, lines 3-8). It also would have been obvious to have provided to the Internet participant instructions for sending payment information since this would have been necessary to complete the transaction. It also would have been obvious to one having ordinary skill to have opened and automatically closed the auction to participants since this is well known in the art at least for setting a beginning and ending time of the auction for the participants. It also would have been obvious to have implemented a world-wide-web interface since this was well known in the art for browsing the Internet. It also would have been obvious to have implemented a packet-switched network for the auctioning system since this is well known in the art as a fast and efficient mode of transmission which would have benefited the auctioning system as described in Sharp at least to quickly notify participants of the most recent bids. It also would have been obvious to have refused bids after a closing time or after a higher bid has been received since these are well known in the auctioning art for finality of the auction itself and finality of sales. It also would have been obvious to have notified the seller in response to receiving information and to have notified bidders of bid acceptance, including by E-mail, since notification would have assured the sellers and buyers of completed transmissions and would have eliminated repeat messages resulting from the users uncertainty of transmissions. It also would have been obvious

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to have advertised on the medium used by participants in Sharp and Salmon since this would have notified users and encouraged participation and would have been obvious to have an indication by the seller for permission to advertise the item since this also would have increased interest in the auction and to have a third party advertise in order to reduce the costs to the participants. It also would have been obvious to keep the asking or reserve price undisclosed since this would have been in the best interests of the seller to obtain the best price possible.

4. Claims 12,14, 15, 17, 24, 25, 34,36-38, 42, 46-48, 51-53, 71-73, 86-89, 98,99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon in view of Sharp and Wright et al. as above further in view of "Internet Providers Take Next Step Toward Electronic Commerce".

The article teaches passing payment information from a host computer to an external clearinghouse and receiving at a host computer a response that payment has cleared (automated clearinghouse payment processing services to businesses), receiving payment information via a worldwide web page server (allow marketers on the www to accept consumers' Visa, MasterCard cards online); inherently debiting an account identified by the payment information and clearing credit card transactions since these are necessary to complete the transaction (either credit card, checking accounts). It would have been obvious to one having ordinary skill in the art at the time of the invention to have implemented the payment system as described in the article in the systems of Salmon and Sharp since the payment processing would have been necessary to implement and complete the transactions described in Salmon and Sharp. Also, it would have

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been obvious to have verification and assent to terms of sale before processing the bid since this would have deterred fraudulent behavior of the participants and would have been a condition of the registration of Sharp.

5. Claims 85,91,92, 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon in view of Sharp and Wright et al as above further in view of Debenedictis et al., patent number 5,625,823.

Debenedictis teaches indicating an opening bid and current bid and notifying a user that a bid has been accepted (fig. 28, col. 28, line 60-col. 29, line 30). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the information of the interface of Debenedictis in the systems of Salmon and Sharp since this would have provided users with the most current information necessary for an online auction.

6. Claim 147 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon in view of Sharp and Wright et al. as above further in view of Keithley et al, patent number 5,584,025.

Keithley et al. teaches acquiring and displaying information or use in the sale of goods or services which includes advertising information (by third party col. 5, lines 35-40,45-55, col. 12, lines 15-22) product tracking identifier (property identifier) and uses a UNIX daemon in its communication handler program (abstract, col. 12, lines 20-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used UNIX as in Keithley et al in the systems of Salmon and Sharp since the systems of Salmon and Sharp do not limit the

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operating systems and since UNIX handles the type of information used and the transactions performed in the systems of Salmon and Sharp.

7. Applicant's arguments filed on 2/2/01 have been fully considered but they are not persuasive.

Applicants comments concerning providing subjective information by the seller is unpersuasive since Sharp does not indicate that any additional message is added by the human operator as apparently suggested by the applicant. Also Salmon clearly shows it is up to the seller to provide item information and description (at least col. 1, lines 40-45, col. 2, lines 30-35). Also, in collectibles and car sales, the condition (excellent, good, or fair) is of primary importance in describing the item and is often used to determine price and raise interest. The inclusion of subjective information is just not non-obvious or novel.

The inclusion of advertising is also not patentable because this information is necessary to generate interest in the item and participation in the auction. Also, see Wright concerning advertising in the above rejections.

The inherency statements stand since the financial of payment information does not necessarily include specific account information or transactions as in the dependent claims. Instead, due to the breadth of the claims, the payment information includes a minimum of information, even an agreement to pay the registration fee- a requirement of Acorn. Also, statements of obviousness have been provided with reasoning as in accordance with the 103 requirements.

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Also, applicant's comments concerning the motivation to combine references is not persuasive. It is maintained that sellers would have an incentive to auction for the possibility of receiving more money than the asking price (meaning minimum bid or reserve price) since sellers do not have to accept any bid considered too low by the seller. Also, advantages are listed in Salmon providing motivation (see at least col. 1, lines 15-25, col. 2, lines 25-55).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nahan et al., patent number 5,664,111 teaches a database showing items for sale where the seller inputs categories and subcategories and includes a network which is worldwide (col. 3, lines 1-2, col. 8 - col. 10) and provides shipping instructions according to the buyer (col. 13, lines 55-65).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)
(for informal or draft communications, please label "PROPOSED" or "DRAFT")
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA.,
Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Kemper, whose telephone number is 703-305-9589. The examiner can normally be reached on Monday-Thursday from 8:30-6:00. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vince Millin, can be reached at 703-308-1065. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-305-3900.

M. Kemper
December 8, 2000



M. Kemper
Primary Examiner
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